

REMARKS

This Amendment is submitted in response to the Office Action dated December 7, 2000. In the Office Action, the Patent Office objected to the abstract of the disclosure because phrases which can be implied, such as "are provided" should not be present therein. The Patent Office objected to informalities in the specification. Further, the Patent Office rejected Claim 14 under 35 U.S.C. §112, first paragraph and second paragraph, as containing subject matter which was not sufficiently described in the specification and as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, respectively. Further, the Patent Office rejected Claims 9, 10 and 14 under 35 U.S.C. §102(b) as being anticipated by *Fischer*; and rejected Claims 15 and 16 under 35 U.S.C. §102(b) as being anticipated by *Martin et al.* Finally, the Patent Office rejected Claims 1-4, 6-8, 17 and 19 under 35 U.S.C. §103(a) as being unpatentable over *Fischer* in view of *Martin*; rejected Claims 5 and 13 under 35 U.S.C. §103(a) as being unpatentable over *Fischer* in view of *Martin* as applied to Claims 1 and 17 and further in view of Applicant's disclosure; and rejected Claim 11 under 35 U.S.C. §103(a) as being unpatentable over *Fischer* in view of Applicant's disclosure.

By the present Amendment, Applicant canceled Claim 10, amended the abstract, specification and Claims 1, 9, 14, 15 and 17. Applicant submits that the amendments to the abstract, specification and claims and the arguments that follow overcome the

objection and rejections thereto as made by the Patent Office and place the application in condition for allowance.

In the Office Action, the Patent Office objected to the abstract and the specification. More specifically, the abstract was objected to because phrases which can be implied should not be present therein. Applicant amended the abstract to remove the phrase "are provided" and submits that the objection to the abstract has been overcome. Notice to that effect is requested.

Further, Applicant amended the specification by removing "largerg13" and inserting "larger" in its place. Further, Applicant removed a paragraph break after paragraph 10 of the DETAILED DESCRIPTION OF THE PRESENTLY PREFERRED EMBODIMENTS to overcome the objections to the specification. Accordingly, Applicant submits that the objections to the specification have been overcome. Notice to that effect is requested.

In the Office Action, the Patent Office rejected Claim 14 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not sufficiently described in the specification. More specifically, the Patent Office stated that it is unclear as to how the tool attaches the clamps to the article. Applicant amended the specification to supplement what is shown in the Figures which identifies how the tool attaches the clamp to the article. The specification now reads "The bands 64 may have screws 66 or other like fastening means that may be attached to the band 60 and utilized to tighten or clamp the bands 64" (at page 8, lines 24-26); "Any number of bands may be utilized to fix or clamp the sheath 60 onto the barrel 52" (At page 8, line 33 to page 9, line

1); and "A tool 68 may be utilized to fasten the screws 66 onto the bands 64 thereby fixing or clamping the sheath 60 to the barrel 52" (At page 9, lines 12-14). Applicant submits that no new matter is being entered as these features were clearly shown in the Figures as filed with the application.

Further, the Patent Office rejected Claim 14 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. More specifically, antecedent basis was required for "the clamps". Applicant amended "the clamps" in Claim 14 to read "the clamp" and amended the dependency from Claim 10 to Claim 9, to provide antecedent basis. Accordingly, the rejections of Claim 14 are respectfully traversed in view of the specification and claim as amended. Notice to that effect is requested.

With respect to the rejection of Claims 9, 10 and 14-16 under 35 U.S.C. §102(b), Applicant respectfully submits that the claims, as amended, overcome the rejections of the Patent Office for the reasons that follow.

More specifically, Claim 9 has been amended to define a marking device accessory kit having a marking device with a barrel and a flat article. The article wraps around the barrel of the marking device and a clamp removably secures the flat article around the barrel of the marking device. Further, Claim 9 was amended to incorporate Claim 10. Accordingly, Claim 10 was canceled.

Claim 15 has been amended to define a marking device accessory kit. The accessory kit has a marking device having an end and an end cap. The end cap fits on the end of the marking device and is interchangeable between a plurality of marking devices. The accessory kit also has a connecting lead having a first end and a second end. The first end is removably connected to the end cap, and the second end is removably connected to a surface remote from the end cap.

Fisher merely teaches an ornamental design for a writing instrument sleeve. The drawings in *Fisher* clearly show a device with stitching. The stitching secures the sleeve around a writing device. Applicant's invention, however, claims a clamping device that may be removed and reapplied.

Martin merely teaches a holder designed to support a writing device suspended above the top of a surface. The holder accommodates different sized pencils or pen holders. Nowhere does *Martin* teach a holder that holds writing devices of varying shapes. The drawings clearly show only a tube shaped writing device. In addition, in *Martin*, the holder of the writing device is attached to a base. Nowhere does *Martin* teach a holder that is removably attached to a surface. Applicant's invention, however, claims a pen cap that is removably attached to a writing instrument and surface.

Under 35 U.S.C. §102, anticipation requires that a single reference discloses each and every element of Applicant's claimed invention. *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1479, 1 USPO 2d. 1241, 1245 (Fed. Cir. 1986).

Moreover, anticipation is not shown even if the differences between the claims and the reference are "insubstantial" and one skilled in the art could supply the missing elements. *Structure Rubber Products Co. v. Park Rubber Co.*, 749 F.2d. 707, 716, 223 USPO 1264, 1270 (Fed. Cir. 1984).

Since neither *Fisher* nor *Martin* teach the elements defined in amended Claims 9 and 15, the rejection under 35 U.S.C. §102(b) has been overcome and should be withdrawn. Notice to that effect is requested.

With respect to the rejection of Claims 1-4, 6-8, 17 and 19 under 35 U.S.C. §103(a) as being unpatentable over *Fischer* in view of *Martin*; the rejection of Claims 5 and 18 under 35 U.S.C. §103(a) as being unpatentable over *Fischer* in view of *Martin* and further in view of Applicant's disclosure; and the rejection of Claim 11 under 35 U.S.C. §103(a) as being unpatentable over *Fischer* in view of Applicant's disclosure, Applicant respectfully submits that the claims, as amended, distinctly define the present invention from any of the art of record, taken singly or in combination, for the reasons that follow.

More specifically, amended Claims 1 and 17 define a marking device and a method for using a marking device wherein an end cap has a connecting lead removably attached to a surface. Further, Claim 17 teaches a connecting lead having a first end and a second end wherein the first end is removably connected to the end cap, and the second end is removably connected to a surface remote from the end cap.

Neither *Fischer* nor *Martin* teach a connecting lead having a first end and a second end wherein the first end is removably connected to an end cap, and the second end is removably connected to a surface remote from the end cap.

The Patent Office submits that "Fischer discloses a marking device covered with a sheath. Although *Fischer* does not disclose the use of an end cap, attention is directed to the *Martin* reference which, as discussed *supra*, discloses an end cap for a marking instrument as claimed in order to enable the marking instrument to be secured to a particular location."

Contrary to this assertion by the Patent Office, the marking instrument in *Martin* is secured only to a base having a small tube. The tube supports a flexible stem to which a clasp carrying a pencil is attached. The pencil in *Martin* may only be secured to this base, whereas, Applicant's invention allows for an end cap having a connecting lead to be removably attached to any surface.

The Patent Office has provided absolutely no teaching as to why one having ordinary skill in the art would have been motivated to modify *Fischer* or *Martin* in the manner suggested by the Patent Office in formulating the rejections under 35 U.S.C. §103(a).

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F. 2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements perform

their ordained and expected functions. The test is whether the invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

Moreover, it is insufficient that the art disclosed components of Applicant's assembly, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by the inventor. *Interconnect Planning Corp. v. Feil*, 774 F. 2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

Even assuming that one having ordinary skill in the art could somehow have combined the references applied by the Patent Office, the resultant combination still lacks the critical features and structural relationships positively recited in the amended claims as set forth above.

With the analysis of the deficiencies of the *Fischer* and *Martin* patents in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103

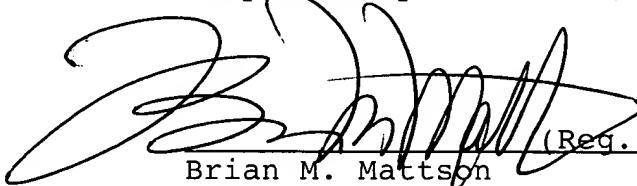
Accordingly, the rejection of Claims 1 and 17 under 35 U.S.C. §103(a) has been overcome and should be withdrawn.

Claims 2-8 depend from Claim 1; Claims 11-14 depend from Claim 9; Claim 16 depends from Claim 15; and Claims 18-20 depend from

Claim 17. These claims are further believed allowable over the references of record for the same reasons set forth with respect to their parent claims since each sets forth additional structural elements and steps of Applicant's marking device with accessory kit and method for using the same, respectively.

In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that this **Amendment** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to the Asst. Commissioner for Patents, Washington, D.C. 20231 on March 7, 2001.



Brian M. Mattson